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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,008	10/11/2005	Yuka Matsushita	2005_1584A	1283
52349 7590 06/25/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
DAGLAWI, AMAR A				
ART UNIT		PAPER NUMBER		
2618				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/553,008

Applicant(s)

MATSUSHITA ET AL.

Examiner

AMAR DAGLAWI

Art Unit

2618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 02/04/2009

DETAILED ACTION

Response to Amendment

Claims 1 and 7-15 are all claims pending in the current application. Claims 1 and 13-15 are cancelled. Claims 16-19 have been added. The amendment has been entered.

Response to Arguments

Applicant's arguments filed on 04/08/2009 have been fully considered but they are not persuasive. Applicant argues that neither of Hasegawa (US 2004/0072592) nor Yamagata (US 2003/0174839 A1) fails to teach a contact less communication by a second wireless communication and a command is received from a reader/writer and analyzed. However, upon review of Hasegawa and give the claims the broadest reasonable interpretation in accordance with MPEP 2111 without incorporating claims from the specification into the claims, the examiner respectfully disagrees and believes that Hasegawa teaches in par [0050] and Figures 2, 6, and 7 when the mobile terminal apparatus approaches or contacts the reader/writer 2, the reader/writer 2 transmits to the mobile terminal a certificate information confirmation signal all to check whether or not the mobile terminal apparatus stores the electric certificate information. Also, upon receipt of the signal a14, the contactless IC card 15 transmits to the reader/writer 2 a mode ON/OFF information acquisition request a15 to acquire the mode ON/OFF information. In response to the request, the reader/writer 2 transmits to the contactless IC card 15 a signal a16 (mode ON/OFF information) for switching ON/OFF of the set state (mode) of the mobile terminal apparatus 1. Upon receipt of the mode ON/OFF information, the contactless IC card 15 transmits the mode ON/OFF information to the

control unit 14 of the mobile terminal apparatus 1. Thus, according to the second embodiment, when a user enters a restricted place, that is, a concert hall, theater, stadium, etc., the user only has to put the mobile terminal apparatus 1 over the reader/writer 2 to automatically switch the set state without manually setting various functions such as the function of "automatically cutting off radio waves" and the like.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa (US 2004/0072591 A1).

With respect to claim 1, Hasegawa teaches A wireless communications terminal capable of performing a contactless communication by which a command transmitted from a predetermined reader/writer is received and which is performed with the reader/writer based on the received command, and at least one wireless communication via a communications network the wireless communications terminal (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]) comprising:

a first wireless communications section operable to perform a wireless communication

a second wireless communications section operable to perform a contactless communication and a wireless communications control section operable to, in an initiation of a contactless communication performed by the second wireless communications section (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]), (i) cause the second wireless communications section to receive the command, (ii) analyze the received command, (iii) automatically deactivate a function of a wireless communication performed by the first wireless communications section, then (iv) cause the second wireless communications section to continue the contactless communication, in accordance with a result of the analysis (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).

With respect to claim 13, Hasegawa teaches A communications protocol switching method used by a wireless communications terminal comprising a first wireless communications section for performing at least one wireless communication via a communications network, and a second wireless communications section for receiving a command transmitted from a predetermined reader/writer and performing a contactless communication with reader/writer based on a the received command, the method (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]) comprising: determining an initiation of a contactless communication performed by the second wireless communications section (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]); causing the second wireless communications section to receive a command, in an initiation of the contactless communication (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]); analyzing the received command,

automatically deactivating a function of a wireless communication performed by the first wireless communications section (abstract, Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]) and then causing the second wireless communications section to continue the contactless communication, in accordance with a result of the analysis (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).

With respect to claim 14, Hasegawa teaches A communications protocol switching program stored on a computer-readable medium that is executed by a wireless communications terminal including a first wireless communications section for performing at least one wireless communication via a communications network, and a second wireless communications section for receiving a command from a predetermined reader/writer and performing a contactless communication with the reader/writer based on a the received command, the program causing the wireless communications terminal to perform the steps (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).of: determining an initiation of a contactless communication performed by the second wireless communications section (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]) ; causing the second wireless communications section to receive a command when initiating the contactless communication: analyzing the received command,-and automatically deactivating a function of a wireless communication performed by the first wireless commtnications section(Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]) ; and then causing the second wireless communications section to continue the contactless

communication, in accordance with a result of the analysis (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).

With respect to claim 15, Hasegawa teaches An integrated circuit used in a wireless communications terminal capable of performing a contactless communication and at least one wireless communication, the wireless communications terminal including a first wireless communications section for performing a wireless communication via a communications network, and a second wireless communications section for performing a contactless communication with a predetermined reader/writer based on a command, the integrated circuit (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]) comprising: a circuit functioning as a wireless communications control section operable to in an initiation of a contactless communication performed by the second wireless communications section, (i) cause the second wireless communications section to receive a command, (ii) analyze the received command, (iii) automatically deactivate a function of a wireless Communication performed by the first wireless communications section, then (iv) cause the second wireless communications section to continue the contactless communication, in accordance with a result of the analysis (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (US 2004/0072592 A1) in view of Yamagata (US 2003/0174839 A1).

Hasegawa teaches all the limitations of claims 16 and 1 except for a first memory area, among a plurality of memory areas having different security levels from each other, having a higher security level; and a Second memory area, among the plurality of memory areas, having a security level lower than the security level of the first memory area, wherein the wireless communications control section causes the second

wireless communications section, in a first case where the received command is requesting access to the first memory area, to continue the performance of the contactless communication after automatically deactivating a function of the wireless communication performed by the first wireless communications section without a time limit, or causes the second wireless communications section, in a second case where the received command is requesting access to the second memory area, to continue the performance of the contactless communication after automatically deactivating a function of the wireless communication performed by the first wireless communications section with a time limit which is taught in related art by Yamagata (See Fig.4, Fig.5, Fig.11, par [0112-0121]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Hasegawa the memory to incorporate the memory regions and controller of Yamagata so as to control the internal operation of the IC chip.

With respect to claim 17, Hasegawa in view of Yamagata further teaches the first memory area is at least one of a TRM area and a secure flash (See Fig.4, Fig.5, Fig.11, par [0112-0121]).

With respect to claim 18, Hasegawa in view of Yamagata further teaches a timer section operable to detect an elapse of a predetermined amount of time since an initiation of a contactless communication, wherein the wireless communications control section removes a restriction on the wireless communication via a communications

network performed by the first wireless communications section based on the detection of an elapse of the predetermined time by the timer section (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).

With respect to claim 19, Hasegawa in view of Yamagata further teaches second wireless communications control section operable to restrict the contactless communication performed by the second wireless communications section based on an instruction from a user (Figs.2-5, Figs.7-8, par [0025], par [0034-0048], par [0048-0056]).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMAR DAGLAWI whose telephone number is (571)270-1221. The examiner can normally be reached on Monday- Friday (7:30 AM- 5:00 AM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NGUYEN DUC can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amar Daglawi
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